

Serial No.: 09/998,204
Atty. Docket No.: P67365US0

REMARKS

The above-captioned application was filed with 8 claims, claims 1-4 being directed to a resonator, and claims 5-8 being directed to a method of making a resonator filter. A restriction requirement was mailed on July 3, 2003, requiring election between Invention I (claims 1-4) and Invention II (claims 5-8), the Examiner stating that Inventions II and I are related as a process of making and product made. Applicants elected Invention II, directed to the process.

In an Office Action on the merits mailed August 6, 2003, claims 5-8 were rejected as being either anticipated by or obvious in view of the prior art.

In response to the Office Action mailed August 6, 2003, Applicants filed an Amendment on November 16, 2003 ("the November Amendment") canceling claims 1-4, amending claims 5-7 and adding claims 9-11. Accordingly, claims 5-11 are pending.

On July 6, 2004, a Communication was mailed from the U.S. Patent and Trademark Office in which the November Amendment was held to be non-responsive as "presenting only claims drawn to a non-elected invention". Specifically, the claims set forth in the November Amendment were held to be not readable on the elected invention because the independent claims as amended or newly presented included size characteristics of resonators (used in making the resonator filter) which were stated to be properly limited to Invention I. Applicants respectfully disagree.

Claim 5 is directed to a method of manufacturing a resonator filter that is made with a plurality of resonators and which has specified impedance characteristics. In the amendments to claim 5 set forth in the November Amendment, the method of making the resonator filter was

amended to clarify that the desired impedance which is set forth as resulting from the method, as well as the reduction in intermodulation distortion achieved by the method, are at least partially effected by controlling the size of the resonators that are used in making the resonator filter. In other words, in order to make a resonator filter having the specified characteristics, the size of the resonators with which the filter is made is controlled. This is merely a clarification of the method and states with greater definiteness *how the method is performed*, i.e., how the desired impedance and intermodulation distortion reduction is achieved. This amendment does not and cannot transform the method claim of claim 5, which is still clearly directed to the method of manufacturing a resonator filter having a plurality of resonators, into a product claim for “a resonator”, as would fall within non-elected Invention I.

Furthermore, the method of manufacturing a resonator filter which Applicants consider to be their invention requires that the size of the resonators which are used to make the resonator filter have certain characteristics and/or limitations. Since the elected invention is that drawn to the method of manufacture of a resonator filter, *Applicants must be allowed to specify the manner by which the resonator filter is made*, namely by forming a plurality of resonators and by controlling the size of such resonators. These limitations properly define the method or process of manufacture. Additionally, these limitations could not be introduced into the non-elected Invention I as it would make no sense to claim the product of a resonator “by controlling the size of the resonators used in the resonator filter”. Thus, being method limitations, Applicants are entitled to present them now when the elected invention is that of the method of manufacturing a resonator

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filter. Accordingly, reconsideration and entry of at least the amendments to claim 5, and claims 6-8 dependent thereon, is proper and respectfully requested.

New claim 9 is also directed to a method for manufacturing a resonator filter to minimize current flowing in each of a plurality of resonators forming the resonator filter in order to reduce an intermodulation distortion. The method includes the steps of forming a plurality of resonators, with the plurality of resonators being formed to have a specified structure, and connecting this plurality of resonators by J inverters in parallel to form the resonator filter. Again, the inclusion of information that clarifies the nature of the resonators that are used in the making of the resonator filter according to the elected method cannot transform the method claim into a product claim. *Applicants must be allowed to further specify how the method is performed.* The fact that size limitations pertaining to the resonators used in the manufacture of the resonator filter were not initially set forth in the method claims as originally filed does not render them improper, particularly when Applicants' broader method claims have been rejected and Applicants, by and through the November Amendment, continue to claim the method of making the resonator filter. Therefore, entry and consideration of claim 9 is also requested, along with claims 10 and 11 that are dependent thereon.

Finally, should the Examiner be unpersuaded relative to the nature of the amendments and claims set forth in the November Amendment, M.P.E.P. 820 provides that when an election has been made between a product and a process and the elected invention has been rejected on the ground that the process is obvious, the presentment of claims drawn to the non-elected invention does not constitute a shift.

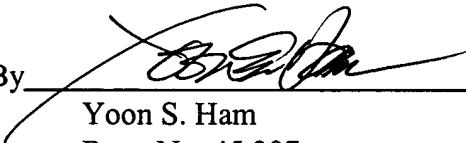
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For at least the foregoing reasons, the November Amendment is presented as properly presenting claims drawn to the elected invention of a method of manufacturing a resonator filter. Entry and favorable consideration thereof is requested.

Should the Examiner have any questions or comments, the Examiner is cordially invited to telephone the undersigned attorney so that the present application can receive an early Notice of Allowance.

Respectfully submitted,

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